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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,333	09/18/2000	Goran Nilsson	3491-42	3777

7590

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EXAMINER

LOPEZ, CARLOS N

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 08/27/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/663,333

Applicant(s)

NILSSON ET AL.

Examiner

Carlos Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

In view of the Appeal Brief filed on 6/14/02, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1) Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3 and 4, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). Claim 4 recites the broad recitation metal, and the claim also recites "preferably stainless steel" which is the narrower statement of the range/limitation "metal".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
- 2) Claims 1-6 and 8 rejected under 35 U.S.C. 103(a) as obvious over Steiner et al (US 5393384) in view of Eklund et al (US 5298124). Steiner uses a belt to guide a paper web through an extended nip press and to transfer the web onto a yankee

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cylinder, forming an extended transfer nip (Fig. 1). Steiner is silent disclosing the claimed transfer belt properties. However, Eklund's claim 1 discloses a paper web transfer belt for the use in a paper machine having a supporting base and a top melted layer containing polymer and or a filler particle. The top melted layer having an air permeability less than $6 \text{ m}^3/\text{m}^2/\text{min}$, a resettable surface roughness in the range of $R_z = 2 - 80 \mu\text{m}$, polymer coating hardness in the range of Shore A 50 to Shore A 97, and the filler contained in the polymer layer having a hardness different from that of polymer coating. A roughness of $R_z = 0 - 20$ when the polymer layer is compressed by a linear load of $20 \text{ kN/m} - 200 \text{ kN/m}$ is applied to the transfer belt (Column 16 lines 52-57). The air permeability of the belt was measured according to "Standard Test Method for Air Permeability of Textile Fabrics", ASTM D737-75 (Column 8 lines 15-18). The filler comprising the belt may be kaolin clay (Claim 21). The polymer coating may be a polyurethane/polycarbonate resin composition (Claim 28). Eklund also discloses that the carrier (woven base) may be woven to produce an endless transfer belt once installed in a paper machine (Column 13 lines 23-36). Eklund also discloses in the abstract that the transfer belt can readily release the paper web due to its recovered uncompressed roughness property and provides optimal removal of the paper web from a press fabric without causing sheet instability problems and may ensure optimal dewatering of the web (Columns 5-6). Furthermore, Eklund's elements 7- 8, 29-30 and 46-47 in figures 1-3 disclose the belt being used in a press nip. It would have been obvious to a person of ordinary skill at the time the invention was made to have substituted use Steiner's transfer belt because it would easily transfer the paper web to

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the yankee cylinder, reduce sheet instability and additionally provide optimal dewatering of a web when passing through a press nip (Eklund Columns 5-6).

As for claim 5, the polymer layer encloses a portion of the carrier shown in Fig. 4.

3) Claim 7 rejected under 35 U.S.C. 103(a) as obvious over Steiner et al (US 5393384) in view of Eklund et al (US 5298124) as applied to claim 1 above, and in further view of Trokhan et al (US 5556509). Claim 7 additionally recites embossing the polymer layer. However, Trokhan shows a belt having an embossed polymer layer to produce an embossed soft tissue (Figure 11). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to emboss Eklund's polymer layer in view of Trokhan to use in Steiner's papermaking machine because it would create an embossed tissue paper while being transferred through the press nip section and at the same time provide optimal dewatering of the web as taught by Eklund.

Response to Arguments

Applicant's arguments filed in Appeal Brief 6/14/02 3/21/02 have been fully considered but they are not persuasive. Applicant's argument that Steiner does not show a reliable transfer of a web directly to a yankee cylinder is moot, Applicant does not claim the effectiveness of said transfer means and as shown explicitly by Steiner a transfer of a web directly to a web is clearly shown in figures 6 and 7. Applicant goes further on the record to state that a transfer from a smooth belt to a smooth cylinder at a nip may not occur reliably if at all (Appeal Brief Page 5). Since Applicant has disclosed that Eklund's belt is being used, Applicant is thus questioning the reliability of the instant claimed

transfer means because Eklund's belt is smooth at a press nip like Steiner's transfer belt which is already smooth in a non-compressed state.

In response to applicant's arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant only provides a piecemeal analysis of the Eklund and Steiner references. Applicant does not provide reasons why a person of ordinary skill in the art would not have been motivated to have merely substituted Steiner's impermeable transfer belt with Eklund's impermeable transfer belt in order to take advantage of the properties provided by Eklund such as reduce sheet instability and additionally provide optimal dewatering of a web when passing a web through a press nip (Eklund Columns 5-6). Instead Applicant recites a catalog of properties of the Eklund and Steiner inventions.

In addressing the rejection made of claim 5, Applicant does not specifically point out how the Lundstrom patent fails to show what is lacking between Steiner and Eklund patents. Additionally in claim 5, the carrier comprised by element 72 is completely enclosed by the polymer layer 80 as shown in figure 1 of Eklund and as provided in Column 2 by Lundstrom's modification.

In addressing the rejection of claim 7, Applicant does not specifically point out how the Trokhan et al patent fails to show what is lacking between Steiner and Eklund

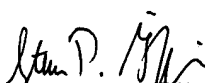
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patents. Trokhan patent uses an embossed transfer belt to provide embossed patterns to a paper web. It would have been obvious to one of ordinary skill in the art to have modified Eklund's belt with an embossed pattern in order to provide an embossed pattern to a web as taught by Trokhan at the same time is being transferred in a press section region .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.


STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

C.L
August 21, 2002